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IBM CORPORATION, INTELLECTUAL PROPERTY LAW
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EXAMINER	
COLAN, GIOVANNA B	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. DETTINGER and CALE T. RATH

Appeal 2009-005742
Application 10/803,603
Technology Center 2100

Before JAMES D. THOMAS, JOHN A. JEFFERY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 4-21, and 24-31. Claims 2, 3, 22, and 23 have been cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention is directed to annotations. More particularly, the invention on appeal is directed to "tracking the status of annotations based on data contained therein." (Spec. 1, ll. 8-9).

Claim 1 is illustrative:

> 1. A method for tracking the status of an annotation, comprising:
>
> creating an annotation record comprising one or more fields for storing annotation data comprising the annotation;
>
> retrieving annotation data stored in the annotation record;
>
> applying a set of state rules to determine a first state of the annotation based on the annotation data; and
>
> receiving additional annotation data;
>
> updating the annotation record with the additional annotation data; and

> applying the set of state rules to determine a second state of the annotation based on the annotation data in the updated annotation record;
>
> providing an indication that the state of the annotation has changed from the first state to the second state.

The Examiner relies on the following prior art references as evidence of unpatentability:

Bays	US 6,519,603 B1	Feb. 11, 2003
Setya	US 2006/0111953 A1	May 25, 2006

Appellants appeal the following rejection:

Claims 1, 4-21, and 24-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bays and Setya.

APPELLANTS' CONTENTIONS

Appellants contend that "neither Bays, nor Setya, alone or in combination, teach[s] or suggest[s] the claim limitations of 'applying a set of state rules to determine a first state of an annotation based on annotation data' and 'applying the set of state rules to determine a second state of the annotation based on the annotation data in the updated annotation record.'" (App. Br. 13).

In particular, Appellants contend that Bays' teaching of filtering or transforming data has no relation to states of annotations. (App. Br. 13-14; *see also* Reply Br. 3-4).

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

> Under § 103, did the Examiner err in finding that the combination of Bays and Setya would have taught or suggested: "applying a set of state rules to determine a first state of the annotation based on the annotation data" and "applying the set of state rules to determine a second state of the annotation based on the annotation data in the updated annotation record," within the meaning of representative claim 1?

GROUPING OF CLAIMS

Based on Appellants' arguments in the Briefs, we decide the appeal on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FACTUAL FINDINGS (FF)

We adopt the Examiner's findings in the Answer and Final Office Action, with respect to the limitation at issue, as our own. (Ans. 4-5). We add the following factual findings:

1. Appellants' Specification discloses:

> [0041] Each state rule *may be* a combinations [*sic.*] of one or more logical statements that examine the contents of one or more of the fields.

> [0042] For some embodiments, more complex rules (than those based solely on the existence or absence of data) may also be created, for example, that define a state of an annotation based on the presence of specified strings in a text field.

(Spec. 11)(emphasis added).

2. Bays teaches filtering and transforming entered annotation content. (Col. 3, ll. 25-26).
3. Bays teaches the looping (i.e., successive) propagation of selected annotations to target data items or data item types according to an administrators' determination. (Col. 10, ll. 21-23, 40-52).

ANALYSIS

Based upon our review of the record, we find unconvincing Appellants' argument that "neither Bays, nor Setya, alone or in combination, teach[s] or suggest[s] the claim limitations of 'applying a set of state rules to determine a first state of an annotation based on annotation data' and 'applying the set of state rules to determine a second state of the annotation based on the annotation data in the updated annotation record.'" (App. Br. 13).

We begin our analysis with claim construction.

"In the patentability context, claims are to be given their broadest reasonable interpretations. . . . [L]imitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from

common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (citation omitted).

Here, Appellants have not established where a definition is set forth in the Specification that provides an artisan with notice of a special or uncommon meaning for the disputed claim terms "state rules" and "state of the annotation." (Claim 1).[2]

Based upon our review of Appellants' Specification, we find an exemplary description of state rules, as follows:

> more complex rules (than those based solely on the existence or absence of data) may also be created, for example, that define a state of an annotation based on the presence of specified strings in a text field.

(FF 1)(underlining added).

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[2] While Appellants contend that Bays "simply does not disclose the present claims" (Reply Br. 4), Appellants do not argue a particular meaning or definition for the disputed claim terms. Nor have Appellants established in the record a common or plain meaning for the claim terms "state rules" and "state of the annotation," for example, by providing a dictionary definition. In addition, there is no declaration of record to consider as evidence regarding the intended metes and bounds of the claimed "state rules" and "state of the annotation."

Given the breadth of Appellants' Specification (*Id.*), we conclude that the Examiner's broader interpretation of the claimed "state rules" and "state of the annotation" is reasonable. (*See* Ans. 16-17). In particular, we agree that defining a state of an annotation based on the presence of specified strings in a text field (FF 1) is a type of filtering using state rules. Thus, we find no support in the record for Appellants' contention that "the Examiner has broadened the claims well past the bounds of the *Application* as read by a person having ordinary skill in the art." (Reply Br. 4).

Given the Examiner's broad but reasonable claim interpretation, we are in accord with the Examiner's finding that Bays' filtering and transforming entered annotation content (FF 1) would have taught or suggested the claimed "applying a set of state rules to determine a first state of the annotation based on the annotation data." (Claim 1).

Regarding the second argued limitation of "applying the set of state rules to determine a second state of the annotation based on the annotation data in the updated annotation record" (claim 1), we find Appellants have failed to address the Examiner's specific findings regarding the annotation propagation loop illustrated by blocks 175 and 180. (Ans. 5; *see also* Bays, Fig. 3D).

On this record, we agree with the Examiner that the claimed updating of the annotation record to a second state of annotation that is determined using applied state rules would have been taught or suggested by Bays looping or successive propagation of selected annotations to target data items or data item types according to an administrators' determination. (FF 3).

CONCLUSION

On this record, we find no reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding the specific limitations disputed by Appellants. Therefore, we sustain the Examiner's obviousness rejection of representative claim 1, and of claims 4-21, and 24-31 (not argued separately), which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We affirm the Examiner's § 103 rejection of claims 1, 4-21, and 24-31.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED

pgc

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